

Appl. No. : 09/528,127
Filed : March 17, 2000

a³
33. A web page generated according to the method of Claim 29, said web page displaying responsive items arranged by category in said order.

REMARKS

The foregoing Amendment is responsive to the Office Action mailed on May 9, 2001.

I. Summary of Amendments

In response to the Examiner's objection to the paper appendices, Applicants have replaced the paper appendices with a computer program listing appendix on CD ROM, and have amended page 1 of the specification accordingly, as set forth in 37 CFR 1.96(c) and 1.52(e). Two identical CD ROMs are enclosed (labeled "COPY 1" and "COPY 2"), each of which contains the four text files now specified on page 1 of the specification. These files are readable using an IBM-PC compatible machine that runs Windows or MS-DOS.

Applicants have also revised the title to correspond more closely to the claims, some of which do not require the "display" of search results data. In addition, Applicants have revised Claim 19 to correct an antecedent basis error, and have added Claims 22-33.

The amendments to the title, specification, and Claim 19 are shown in redline form on the attached page titled VERSION WITH MARKINGS TO SHOW CHANGES MADE.

No new matter has been added to the application by this Amendment.

II. Art-based Rejection

In the Office Action, the Examiner rejected all of the claims under 35 U.S.C. § 103 as being obvious over the combination of U.S. Patent 5,640,553 ("Shultz") and 6,182,050 ("Ballard"). Applicants will treat Ballard as prior art for purposes of responding to this Office Action, but reserve the right to later establish, by swearing behind or otherwise, that Ballard is not prior art. For the reasons set forth below, Applicants respectfully submit that the obviousness rejection is improper, and request that the rejection be withdrawn.

A. The references relied upon by the Examiner do not disclose or suggest every limitation of the invention as claimed.

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. In this case, the combination of Schultz and Ballard fail to satisfy this basic requirement.

With respect to Claim 1, for example, neither Schultz nor Ballard discloses or suggests “using at least the sets of items identified in (a) to determine category significance levels that indicate, for each of the plurality of categories, a level of significance of the category to the query,” as set forth in sub-paragraph (b). In connection with this claim language, the Examiner asserts that Ballard teaches the determination of category significance levels for each of a plurality of categories. Applicants assume the Examiner is referring here to the ability for users to pre-specify their affinity rankings for various categories, as set forth at column 2, lines 25-28. Even if such affinity rankings can be viewed as “category significance levels,” they do not “indicate ... a level of significance of the category to the query” as set forth in Claim 1. In addition, these affinity rankings are not determined “using at least the sets of items” that satisfy the search query, as required by the claim.

Schultz and Ballard also fail to disclose or suggest “presenting the plurality of categories to the user, together with associated items that satisfy the search query, in a display order which depends upon the category significance levels,” as set forth in sub-paragraph (c) of Claim 1. In this regard, the relevance ranking disclosure of Schultz appears to deal only with the ordering of the search result items (documents) themselves, and not the ordering of the categories in which such items fall. Ballard similarly does not involve the ordering of categories for display.

Schultz and Ballard also fail to disclose limitations recited in independent Claims 9 and 17. With respect to independent Claim 9, for example, neither Schultz nor Ballard discloses or suggests “determining, for each of the plurality of categories, a level of significance of the category to the query.” In addition, Schultz and Ballard fail to disclose or suggest “displaying the plurality of categories and associated items to the user according to at least the category significance levels.”

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With respect to independent Claim 17, neither Schultz nor Ballard discloses or suggests a query server that does either of the following: “(b) for each of the multiple categories, determines a level of significance of the category to the query,” or “(c) displays the multiple categories to the user in a display order which depends upon the category significance levels.”

Schultz and Ballard also fail to disclose or suggest many of the limitations recited in Applicants’ dependent claims. By way of example and not limitation, neither reference discloses the use of item popularity scores as defined in Claims 3, 14, 18 and 19.

Because the cited references do not disclose or suggest all of the claim limitations, the rejection over Schultz and Ballard is improper.

B. The Examiner has not identified a valid suggestion for combining the cited references, and no such suggestion exists in the references.

Applicants further respectfully submit that the Examiner has failed to identify a sufficient suggestion or motivation to combine or modify Schultz and Ballard. Applicants further submit that no such suggestion or motivation exists within these references.

As set forth in MPEP 2143.01, in order to establish obviousness based on a combination of references, the prior art must suggest the desirability of the claimed combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (emphasis original), citing *In re Mills*, 916 F.2d 680; 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, the Examiner has failed to identify any such suggestion.

In the Office Action, the Examiner appears to take the position that Schultz and Ballard are combinable under § 103 because the combination would provide an efficient means to call to the user’s attention “all related items that satisfy the query from different categories.” Office Action at paragraph 5. The Examiner’s assertion, however, fails to consider the desirability of bringing the categories to the user’s attention as set forth in the rejected claims.

As described in the present application, an important benefit of this feature is that it “increases the likelihood that the categories that are of most interest to the user will be presented near the top of the search results listing, or otherwise called to the attention of the user.” See page 3, lines 14-16 of the present application. This important benefit is neither taught nor

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suggested by Schultz and Ballard. In fact, neither reference appears to even suggest informing the user of the categories to which the search results correspond.

Applicants further submit that one skilled in the art would not be motivated to combine Schultz and Ballard, as asserted by the Examiner, since Ballard does not involve the field of query processing.

In view of the foregoing, Applicants submit that the rejection over Schultz and Ballard is improper.

III. Post-Action Information Disclosure Statements

Since the mailing of the Office Action, Applicants have filed a Supplemental Information Disclosure Statement to submit the International Search Report and a cited reference from a counterpart PCT application.

In addition, Applicants are submitting herewith a Supplemental Information Disclosure Statement to submit U.S. Patent Nos. 6,185,558 (which corresponds to previously-submitted PCT publication WO 99/45487), 6,006,225, and 6,032,145. The '145 patent discloses the display of search result items together with the categories to which they correspond (see Figures 3 and 4).

None of the newly cited references discloses the ordering of item categories as defined in Applicants' claims.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants submit that the application is now in condition for allowance.

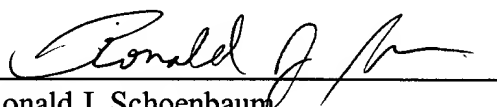
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If any issues remain which can potentially be resolved by telephone, the Examiner is invited to call the undersigned attorney of record at his direct dial number of 949-721-2950.

Respectfully submitted,

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Dated: August 24, 2001

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Amendment to Title:

SYSTEM AND METHOD FOR [DISPLAYING] PRESENTING MULTIPLE-CATEGORY
SEARCH RESULTS

Amendment to "Appendices" section at page 1:

This specification includes a [partial source code listing]computer program listing appendix
consisting of [one aspect of a preferred embodiment of the invention, attached as]
Appendices A, B, C and D[. These materials form a part of the disclosure of the
specification], which are stored on CD-ROM as the following files, respectively:
Appendix A.txt (13.4 Kbytes), Appendix B.txt (17.2 Kbytes), Appendix C.txt (8.16 Kbytes),
and Appendix D.txt (15.2 Kbytes), all created on August 22, 201. These files, which are
incorporated herein by reference, contain a partial source code listing of one aspect of a preferred
embodiment of the invention. The copyright owner has no objection to the [facsimile]
reproduction of this code listing as part of this patent document, but reserves all other copyrights
whatsoever.

Amendment to Claim 19:

19. (Amended) The search engine system as in Claim [17] 18, further comprising a
component that determines the item popularity levels based on at least one of the following types
of user activity: (i) selecting an item from a list of search results, (ii) placing an item in a
shopping cart, and (iii) purchasing an item.

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